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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,944

03/31/2004

Frank Westendorf

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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT

PAPER NUMBER

2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/812,944

Applicant(s)

WESTENDORF ET AL.

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted, or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response the applicants' amendment received on December 15, 2006.
2. Claims 1-35 are presented for examination.
3. The applicants have amended claims 1 and 16. The applicants have not cancelled or added any claims.
4. Applicants' arguments with respect to claims 1-35 have been fully considered but they are not deemed to be persuasive.

### **Remarks**

5. The examiner acknowledges and thanks the applicants for the amendment to claims 1 and 16. However, the newly added claim limitations to claims 1 and 16 including "to assign an action to said determined data objects and to said initial data object" does not overcome the 35 USC 101 rejection. The examiner has maintained the 35 USC 101 rejection for the reasons stated in the office action below.

### **Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

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Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject. Claims 1 and 16 are directed to identifying an initial data object that is to be processed as a selected object, a process chain contains the selected data object that is to be processed. A determination is made to determine the data objects that are linked with the selected data object as a causal relation and processing the determined objects and the initial object to assign an action to the determined data objects and to the initial data object.

The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete and tangible result.”** *State Street, 149 F.3d at 1373, 47 USPQ2s at 1601-02. MPEP 2106*. In each of these cases the **result** identifying, selecting, and processing the selected data object. The claimed limitations are an abstraction as they are not **useful, concrete, and tangible** they are not put in any tangible form and not useful because they are not presented in such a way as to produce and/or provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not **producing a “useful, concrete and tangible result.”**

At best the claim limitations are identifying an initial data object that becomes a selected object. The selected object is processed in a chain of data objects. A determination is made that links the selected object as a causal relation. A process is performed on the determined objects and initial object to “assign an action” to the determined objects and the initial object.

The claim limitations do not produce a useful, concrete, and tangible result. The data objects are assigned an "action". This assigned "action" must perform and produce a result. The claim limitations do not recite in detail what this "assigned action" is nor do the claims recite in detail what would be the end result of performing a particular "action" to the data objects.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 16 recite claim limitations as follows:

(1) chains of linked data objects, (2) initial data object, (3) chain containing said selected data object, (4) selected data object in a causal relation, (4) determined data objects, and (5) an action

The claim limitations do not include a detailed description about the type (attributes) of data objects (initial, selected, determined, etc.) that are presented in the claims nor do the claims include a detailed description (attributes) including the functionality of chains containing links, chains of data objects, causal relation, and an action.

Simply put, what is an "action", "chains of linked data objects", "causal relation", etc.

***Response To Applicants' Arguments***

10. Applicants' arguments recite the following: "applicants note the current application is entitled to priority dates of March 31, 1003 and August 30, 2003 in accordance the properly filed PCT Applications PCT/EP03/04518 and PCT/EP03/03334, respectively. The *Sumino* reference applied by the Examiner has a PCT filing date of May 22, 2003. Both priority dates of the current application predate the *Sumino* filing date. Accordingly, *Sumino* is not valid prior art under 35 U.S.C. § 102(e), and the rejection should be withdrawn."

The examiner does not agree with the applicants' arguments. The applicants are correct that the *Sumino* reference has a PCT filing date of May 22, 2003. However, the *Sumino* reference has and is entitled to the filing date of May 24, 2002. The *Sumino* reference has foreign priority to Japanese application no. 2002-150174 filed on May 24, 2002. The priority date of this Japanese application predates the applicants' priority dates of March 31, 1003 and August 30, 2003 to applications PCT/EP03/04518 and PCT/EP03/03334. Therefore, the examiner has maintained the 35 U.S.C. § 102(e) rejection presented in the office action below.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sumino et al. (Pub. No.: US 2006/0064330 A1 filed May 22, 2003, hereinafter Sumino).

13. Regarding Claims 1, 16, and 17, Sumino teaches an insurance contract support system.

The method and associated system for an insurance contract support system as taught or suggested by Sumino includes:

identifying at least one initial data object to be processed has been selected (paragraph 0109-0114, "Auto Insurance (renewal)", 'application form for renewal contract'), at least one process chain containing a selected data object to be processed (paragraph 0109-0114, "Auto Insurance (renewal)", 'application form for renewal contract'); determining all of the data objects (paragraph 0109-0114, "Auto Insurance (renewal)", 'application form for renewal contract') which are linked with a selected data object (paragraph 0109-0114, "Auto Insurance (renewal)", 'application form for renewal contract') in a causal relation (paragraph 0109-0114, '...a list of expiration information of the customer in charge of the sales representative of the insurance agent to the terminal device 3.

The list of expiration information on the display of the terminal device 3 contains the names 25332 of the customers each having the insurance policy close to the expiration as shown in FIG. 12. '); and processing determined data objects and initial data object (paragraph 0109-0114, "Auto Insurance (renewal)", 'application form for renewal contract') to assign an action to determined data objects and to initial data object

(paragraph 0109, (1) 'required renewal contract application form 2541'; (2) 'three types of recommended insurance advice for renewal contract are displayed'; (3) 'selecting "Modified Contract" 25336 on the display, other contract information is displayed'; and (4) 'pressing "Trial-calculation" 25337, a command for trial calculation of insurance premium').

14. Regarding Claims 2 and 18-20, Sumino teaches resetting determined data objects (paragraph 0109-0114); executing a desired processing of the initial data object (paragraph 0109-0114); and recalculating consecutively determined data objects reset in the resetting step being in causal relation with initial data object (paragraph 0109-0114, 'premium trial-calculation database' and 'trial-calculation result').

15. Regarding Claim 3, Sumino teaches resetting and recalculating the step of cancelling a determined data object (paragraph 0109-0114).

16. Regarding Claims 4-6 and 21-24, Sumino teaches data objects contain a time index and data objects starts with the data object containing the most recent time index and steps back consecutively to a selected data object (paragraph 0109-0114).

17. Regarding Claims 7-10, Sumino teaches all data objects are locked from access upon selection of a data object until termination of the step of processing (paragraph 0109-0114).

18. Regarding Claims 12-15 and 30-35, Sumino teaches grouping and sorting data objects (paragraph 0101).



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19. Regarding Claims 25-29, the limitations of these claims have been noted in the rejections of claims 2, 7-10, and 18-20 presented above. It is therefore rejected as set forth above.

**NAME OF CONTACT**

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first name "Cheryl" written in a larger, more prominent script than the last name "Lewis".

Cheryl Lewis  
Patent Examiner  
February 28, 2007